

Serial No. 09/574,456
Docket No. 7568M
Response date Aug. 29, 2005
Reply to Office Action of April 27, 2005

REMARKS

Status of claims

Applicants thank the Examiner for the consideration given to the present application. Claims 12-16 are pending in the present application. Claim 12 has been amended. Support for the amendment is found in the specification and drawings and thus no new matter has been added.

Rejections Under 35 U.S.C. §102

Claims 12-16 have been rejected under 35 U.S.C. 102(b) as being anticipated by each of Applicant's admitted prior art and Koslow et al. (U.S. Patent No. 5,922,803; hereinafter "Koslow"). The Examiner stated that the admitted prior art and Koslow appear to be structurally identical to the filter recited in claims 12-16, and since the "information" recited in element (b) of claim 12 is not functionally related to the filter recited in element (a) of this claim, the "information" is deemed to be a set of instructions and does not distinguish the invention from the two references (admitted prior art and Koslow) in terms of patentability. *In re Ngai*, 70 USPQ.2d 1862 (CAFC 2004). Applicants respectfully traverse these rejections.

Under §102, a prior art reference must teach each and every element of the recited claim. It is well settled that differences between an invention and prior art cited against it cannot be ignored merely because those differences reside in the content of printed matter. *In re Gulack*, 217 U.S.P.Q. 401, 403 (Fed. Cir. 1983). It is impermissible to dissect a claim, excise printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable; rather, the claim must be read as a whole. *In re Gulack*, supra. As the Federal Circuit has specifically noted, the fact that printed matter by itself is not patentable subject matter, because non-statutory, is not reason for ignoring it when the claim is directed to a combination; rather, the court looks to determine if a functional relationship exists between the printed matter and the remaining claim elements. *In re Gulack*, supra at 404.

Applicants' independent claim 12, as amended, recites, *inter alia*, a filter including a filter core disposed within said housing consisting essentially of particles selected from the group of activated carbon particles and non-carbonaceous particles; and wherein said carbon particles have an interparticle spacing wherein the filter has a VRI of at least about 99.99% at a flow rate

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of 100 mL/min. at 1 hour at an influent concentration of 5×10^8 MS-2 bacteriophages per liter; and printed matter which communicates to a user that the filter may be used to remove nano-sized pathogens from a liquid.

Applicants submit that, contrary to the Examiner's assertion, there is a functional relationship between the recited filter and printed matter, as the printed matter recognizes previously undisclosed features of the filter and adopts the filter for a previously undisclosed use and benefit of the filter. Therefore, Applicants suggest that by asserting this limitation is a mere instruction, lacking a functional relationship to the filter, the Examiner has impermissively excised the printed matter from the claim and thus failed to read the claim as a whole. *In re Gulack*, supra at 403.

Moreover, Applicants have submitted and enclosed herewith a Supplemental Information Disclosure Statement in accordance with 35 C.F.R. §1.97, citing two references: 1) A Ceramikx® Filter Brochure for the admitted prior art filter, dated January 28, 2002 and published by KX Industries, L.P. at its website, www.kxindustries.com (hereinafter "Filter Brochure 1"); and 2) A Ceramikx® Filter Brochure for the admitted prior art filter, dated January 2005 and published by KX Industries, L.P. at its website, www.kxindustries.com (hereinafter "Filter Brochure 2"). As evidence that the recited "printed matter" in Applicants' claim 12 is more than an instruction, Applicants note that on page 2, under sub-heading "Warnings", the Filter Brochure 1 states, "Use Matrikx® carbon filters only with microbiologically safe and adequately disinfected water. Activated carbon filter are not designed to kill or remove viruses." Applicants further note that as late as January 2005, the art was still teaching away from Applicants' recited claim 12 as exemplified by the published statement, "Use this Ceramikx® carbon filter only with microbiologically safe and adequately disinfected water, as it is not designed to kill or remove bacteria or viruses". page 2, sub-heading "Warnings", Filter Brochure 2. In addition, both Filter Brochure 1 and 2 state that Ceramikx® carbon filter (i.e., the admitted prior art) is made or covered by several U.S. Patents, including the Koslow patent. See footnotes of Filter Brochures 1 and 2. Thus, Applicants submit that the recited limitation, "printed matter which communicates to a user that the filter may be used to remove nano-sized pathogens from a liquid," is functionally related to the filter in that it communicates to overcome the clear

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"teaching away" from bacteria and/or virus removal. Thus, the printed matter is an element that cannot be ignored.

When the claimed article is properly evaluated as a combination of elements including, *inter alia*, "printed matter which communicates to a user that the filter may be used to remove nano-sized pathogens from a liquid"; and a filter core including, *inter alia*, activated carbon particles having a VRI of at least about 99.99% by volume, neither the admitted prior art nor Koslow anticipate Applicants' independent claim 12 as neither teaches Applicants' printed matter. Moreover, as evidenced by Filter Brochures 1 and 2, Applicants submit that the teachings of the prior art, actually teach away from Applicants' claimed combination. Accordingly, Applicants respectfully request the withdrawal of the rejections of independent claim 12 under §102(b). As claims 13-16 depend from independent claim 12, Applicants request that the rejections of these claims be withdrawn as well.

CONCLUSION

Applicants respectfully submit that the present application is in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,

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